



21 NOV 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FISH & RICHARDSON, PC
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

In re Application of
CRITTEN et al.
Application No.: 10/510,403
PCT No.: PCT/GB03/01493
Int. Filing Date: 04 April 2003
Priority Date: 05 April 2002
Attorney's Docket No.: SD-Amour-SCH-1005-2-jhp
For: USER AUTHENTICATION FOR
COMPUTER SYSTEMS

DECISION ON
PETITION
UNDER 37 CFR 1.47(b)

This is a decision on Applicant's "Renewed Petition under 37 CFR 1.47(b)", filed 05 September 2006 to permit petitioner (applicant) to file the above-captioned application on behalf of the non-signing inventors, Richard Critten, James Edward Charlesworth, Andrew Larter, Peter Green and Tracy John Dale. Applicant requests a five month extension of time, which is granted. A petition to withdraw the Notice of Abandonment was also submitted.

BACKGROUND

On 04 April 2003, applicant filed international application No. PCT/GB03/01493 which claimed a priority date of 05 April 2002, and which designated the United States. A copy of the international application was communicated to the United States by the International Bureau on 23 October 2003.

On 05 October 2004, prior to the expiration of the 30 month period from the priority date, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, basic national filing fee.

On 11 March 2005, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS indicating that the oath or declaration of the inventor must be furnished within two months from the mail date of the notice or the application would be abandoned. Extensions of time were available.

On 11 October 2005, petitioner filed a petition requesting that the above-identified application be accepted under the provisions of 37 CFR 1.47(b). The petition was not accompanied by a Statement of Facts under 37 CFR 1.47, based upon first hand knowledge, regarding the nonsigning inventors' refusal to sign the application. A declaration was not presented which was executed under 37 CFR 1.47(b), on behalf of the non-signing inventors.

On 03 February 2006, a decision dismissing applicant's petition was mailed indicating that

applicant had failed to meet the requirements under 37 CFR 1.47(b). Petitioner's attention was directed to Manuel of Patent Examining Procedure (MPEP) Section 409.03 et. seq. for instruction on fulfilling the requirements of 37 CFR 1.47.

On 17 July 2006 a Notification of Abandonment was mailed indicating that applicant had failed to respond to the 905 mailed on 11 March 2005.

On 05 September 2006, applicant filed the instant renewed petition along with a request to withdraw the holding of abandonment.

DISCUSSION

A review of the application file reveals that the Notification of Abandonment mailed on 17 July 2006 was sent in error. Applicant did respond to the 11 March 2005 Notification of Missing Requirements on 11 October 2005 along with a request for a five month extension of time which was granted. The Notification of Abandonment mailed on 17 July 2006 is hereby VACATED.

As previously stated, a petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Petitioner previously provided the petition fee satisfying Item (1). Regarding Item (3), the petition provides the last known address for each of the non-signing inventors. Item (3) is satisfied.

With respect to Item (2), the petition does not include a statement of facts signed by a person having firsthand knowledge of the facts recited therein. The petition does not offer any evidence to prove that the inventors named in PCT/GB03/01493 cannot be reached or located. Petitioner states "that our client has not been able to contact all the inventors". The fact that the inventors cannot be found or refuse to sign because they are no longer in the employ of the assignee or because they have not provided signed declaration for this application is not sufficient. Thus, an acceptable reason for filing under 37 CFR 1.47 has not been provided and Item (2) is not satisfied. See Manuel of Patent Examining Procedure (MPEP) Section 409.03(d).

With respect to Item (4), Petitioner has not identified the 37 CFR 1.47(b) applicant. Petitioner has not submitted a declaration under 37 CFR 1.47(b), executed by the 37 CFR 1.47(b) applicant. The declaration presented identifies only one of the five inventors. The declaration must meet the requirements of 37 CFR 1.497(a) and (b). Pursuant to 37 CFR 1.64(b), where the person making the declaration is not the inventor, the declaration must state the relationship of the person to the inventor, and upon information and belief, the facts which the inventor is required to state. Furthermore, petitioner is advised, where the oath or declaration is being signed on behalf of an assignee, see MPEP §324. Item (4) is not satisfied.

Regarding item (5), petitioner did not attempt to prove that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the subject matter to justify filing the application. The 37 CFR 1.47(b) applicant must make out a *prima facie* case (1) that the invention has been assigned to him or her or (2) that the inventor has agreed in writing to assign the invention to him or her or (3) otherwise demonstrate a proprietary interest in the subject matter of the application. Merely attaching copies of copies of United Kingdom patent publications does not satisfy the above

criteria. *See* MPEP §409.03(f). Item (5) is not satisfied.

Finally, with respect to Item (6), applicant has not provided a statement to the effect that "such action is necessary to preserve the rights of the parties or to prevent irreparable damage". *See* MPEP §409.03(g) Thus, Item (6) is not satisfied. See MPEP Section 409.03(g).

Accordingly, items (2), (4), (5) and (6) above have not been satisfied and the petition under 37 CFR 1.47(b) must be dismissed.

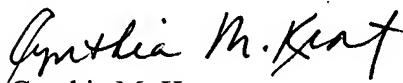
CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED WITHOUT PREJUDICE**.

For the reasons set forth above, the Notification of Abandonment mailed on 17 July 2006 is **VACATED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Tel: 571-272-3286
Fax: 571-273-0459